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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,373	05/19/2005	Hidetaka Oka	EL/2-22798/A/CGJ 130/PCT	9344
324	7590	12/29/2008	EXAMINER	
JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591			JOHNSON, CONNIE P	
			ART UNIT	PAPER NUMBER
			1795	
			MAIL DATE	DELIVERY MODE
			12/29/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/535,373

**Applicant(s)**

OKA ET AL.

**Examiner**

CONNIE P. JOHNSON

**Art Unit**

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 6 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6 and 11-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. The remarks filed 9/15/2008 have been entered and fully considered.
2. Claims 1-3, 6 and 11-13 are presented.

***Claim Rejections - 35 USC § 103***

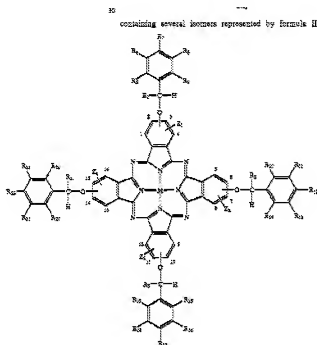
3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 6, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ushirogouchi et al., U.S. Patent No. 5,691,101 in view of Titterington et al., U.S. Patent No. 6,726,755 B2.

Ushirogouchi teaches a photosensitive composition comprising a compound that generates acid when irradiated with light and an acid crosslinked resin (col. 2, lines 32-33). The composition may also comprise glycidyl-methacrylate (monomer) and an epoxy resin (see col. 6, lines 53 and 65-67). The composition may also comprise an epoxy resin that is modified to be alkali-soluble with acrylic acid or a carboxylic acid derivative (col. 7, lines 1-4). The reference also teaches that the photosensitive composition is coated onto a substrate (col. 3, lines 12-14). Ushirogouchi also teaches dyes and pigments in the photosensitive composition. Suitable pigments (colorants) include phthalocyanines (col. 9, line 3). Ushirogouchi does not specifically teach phthalocyanine green colorant in the photosensitive composition.

However, Titterington teaches an ink composition comprising a colorant of the compound:



Wherein R<sub>1</sub> to R<sub>4</sub> are each a 1-6 C alkyl, R<sub>5</sub> to R<sub>24</sub> are each hydrogen, a halogen, a 1-6 C alkyl and M is a divalent metal atom, such as copper (see col. 20, formulas (II) and (III) and col. 21, lines 1-5). A film with a mixture of the copper phthalocyanine colorant with a binder is formed on a base to obtain a recording layer (col. 21, lines 5-8). Titterington teaches that the copper phthalocyanine colorant provides a strong spectral strength (absorbance) in the recording composition (col. 28, lines 53-62). It would have been obvious to one of ordinary skill in the art to use the copper phthalocyanine colorant in the photosensitive composition of Ushirogouchi because Ushirogouchi teaches phthalocyanines as suitable light-absorbing pigments in the photosensitive composition.

5. Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al., U.S. Patent No. 4,789,620 in view of Homeier et al., U.S. Patent No. 4,039,585.

Sasaki teaches a photosensitive composition comprising an alkali-soluble monomer or oligomer (col. 5, lines 45-60). The composition also comprises a photoinitiator (see abstract). Sasaki also teaches an epoxy compound (col. 4, line 50). The reference also teaches that the composition comprises a vinyl monomer component (col. 7, lines 3-4). The composition also comprises a phthalocyanine green pigment (see examples in columns 12-16). Sasaki does not teach that the phthalocyanine green colorant has the structure as in the formula of instant claim 3.

However, Homeier teaches synthesizing a tetrahydroxyphthalocyanine dye with substituted groups. Homeier teaches copper tetrahydroxyphthalocyanine dyes as a catalyst in an olefin hydroformylating reaction. Although Homeier may not specifically teach that the copper tetrahydroxyphthalocyanine is used in a photosensitive composition, phthalocyanine dyes are well known in radiation sensitive compositions. Homeier also teaches hydroxyl groups as substituents for the same structure. Therefore, it would have been obvious to one of ordinary skill in the art to use the phthalocyanine of Homeier in the composition of Sasaki because Sasaki teaches substituted phthalocyanine dyes in radiation sensitive compositions to sensitize the composition, while Homeier teaches the specific phthalocyanines.

### ***Response to Arguments***

6. Applicant's arguments filed 9/15/2008, with respect to the rejection(s) of claim(s) 1, 2, 3, 6 and 11-12 under 103(a) and claims 1 and 13 under 103(a) have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, new ground(s) of rejection are made herein.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CONNIE P. JOHNSON whose telephone number is (571)272-7758. The examiner can normally be reached on 7:30am-4:00pm Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Connie P. Johnson  
Examiner  
Art Unit 1795

/Cynthia H Kelly/

Supervisory Patent Examiner, Art Unit 1795